

REMARKS

The present amendment is in response to the Office Action dated January 2, 2004, where the Examiner has rejected claims 1-15. By the present amendment, claims 3, 5, 10, 11, 13, and 15 are cancelled, claims 1, 2, 4, 7, 9, 12, and 14 are amended, and claims 16-26 are added. Accordingly, claims 1, 2, 4, 6-9, 12, 14 and 16-26 are pending in the present application. Reconsideration and allowance of the pending claims in view of the amendments and the following remarks are respectfully requested.

A. Objection to the Drawings.

In response to the Examiner's objection to the drawings, Applicant submits herewith two (2) sheets of formal drawings.

B. Objection to the Specification.

The Examiner identifies an inconsistency of reference designators in the specification. In response applicant amends the paragraph on page 10, beginning on line 11. Specifically, Applicant amends, on page 10, line 17, "block 200" to --block 302--.

C. Rejection of Claims 1-15 under 35 U.S.C. §102(e)

The Examiner rejects independent claims 1-15 the claims dependent thereupon, under 35 U.S.C. 102(e) as being anticipated by the Gudjonsson Patent No. 6,564,261 (hereinafter the '261 patent). Applicant respectfully traverses the Examiner's rejection.

To anticipate a claim under 35 U.S.C. sections 102(a), (b), or (e), the reference must teach every element of the claim. (See MPEP 2131.) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Emphasis added) (Verdegaal Bros. v. Union Oil Co. of California; see also MPEP 2131.) "The identical invention must be shown in as complete detail as is contained in the ... claim." (Richardson v.

Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); see also MPEP 2131).

Further any claim depending from base claims not anticipated or made obvious by the prior art also are not anticipated or made obvious by the prior art since the dependent claims comprise all of the elements of the base claims.

The '261 patent does not teach each and every element of the independent pending claims, 1, 16, and 25 as discussed below. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending claims.

a. Independent claim 1, and dependent claims 2, 4, 6-10, 13

Independent method claim 1 is not anticipated in view of the '261 patent since the '261 patent fails to teach or suggest each and every element of independent claim 1. Specifically, method claim 1 comprises, among other things,

- (a) "terminating said data connection between said wireless communications device and the wireless communications network;"
- (b) "receiving an indication from the wireless communication network to the proxy server that the wireless communications device is in the active state;"
- (c) "transmitting from the proxy server to the instant messaging service presence information indicating that the user is online; and"
- (d) "maintaining said presence information for the user while the wireless communications device remains in said active state."

As claimed, the wireless communications device does not maintain a data connection line, but rather the "data connection between the wireless communications device and the wireless communications network" is terminated (see element (a)). As noted in the definition of instant messaging, paragraph 2, of Appendix A, in order for instant messaging to work, both users must be online at the same time. In the present invention, the "user", that is, the mobile communications device "terminates its data connection", and is thus not "online". (See [http://searchmobilecomputing.techtarget.com\(whatis.com\).](http://searchmobilecomputing.techtarget.com(whatis.com).))

The mobile communications device of the present invention does not maintain an open data line with the wireless communications network for a variety of reasons as follows: maintaining an open data line wastes wireless communications network resources, maintaining an open data line equates to expensive airtime charges for the mobile communications device, and maintaining an open data line quickly drains the battery of the mobile communications device. (See Applicant's specification pages 1-2 "Background of the Invention".) To overcome these problems, and as claimed in claim 1, the mobile communication device indicates on a wireless data connection to the wireless communication network that it is active, for example, upon power up or upon selection of an instant messaging option. (See Id. at page 11, lines 7-20.) The data connection is then terminated. (See Id. at page 11, line 20.) However, the wireless communication device is still active. As claimed, the wireless communication network then communicates the active status to the proxy server (see element (b)), which is the device that logs into the instant messaging service (see element (c)), and stays on-line in proxy for the wireless communications device (see element (d)). In other words, the proxy server stands in the place of the wireless communications device so that an "online presence" is maintained whether the mobile communications device is idle or actively communicating with the mobile communication network. (See Id. at page 12, lines 7-10.)

Claim 1, as illustrated in Figure 1, clearly claims Applicant's inventive method which is in contrast to the structure and method described in the '261 patent. Specifically, in column 3, lines 46-63, as cited by the Examiner, instant messages are sent to the "intermediate" server so that a user may hide or mask personal information, and "may establish a communication session with another user without knowledge of the client device being used by the other user.... regardless of the client device being used by the called user." The '261 does not describe "terminating said data connection between said wireless communications device and the wireless communication network" (see element (a)). This reference is in contrast to Applicant's invention which informs the instant messaging service when the mobile communications device is truly

active. Also, the present invention does not attempt to hide the identity of the mobile communications device as disclosed in the '261 patent.

Continuing, in column 7, line 64-67, as cited by the Examiner, the '261 patent teaches that the system allows a user to access his or her data from any communication device, including a mobile phone. This teaches away from the present invention wherein the user's mobile communication device is in an active state to receive instant messages via the proxy server connected to the wireless communications network. Thus, the '261 patent neither teaches nor suggests the method of claim 1 wherein a mobile phone indicates its true "active status" to a proxy server through a wireless communication network, which proxy server then maintains an on-line status with the instant messaging service leaving the mobile communication device free to terminate a data connection.

Continuing with the Examiner's rejections, the examiner cites column 11, lines 21-27 of the '261 patent. Although the cited paragraph utilizes the terminology "proxy" while describing an "inter-cluster service, that acts as a proxy between services", and in column 17, referring to Figure 13, an "online status service proxy 51" is described, the Examiner should appreciate that this reference does not teach or suggest Applicant's claimed invention. That is, the '261 patent use of "proxy" is not the proxy server claimed by Applicant which stands in the place of the mobile communication device to maintain an on-line connection on the data network.

On page 2 of the office action, the Examiner asserts that the '261 patent teaches "terminating said data connection" as claimed by Applicant. Applicant respectfully disagrees. Specifically, the Examiner cites column 11, line 45-47 and Figures 8, 20, 21. Column 11, lines 45-47 and Figure 8 merely describes a contact list indicating on-line status. Figures 20 and 21 illustrate a logon and a logoff status of a user. This is different from the claimed "terminating said data connection". The logging on and off of the instant messaging service is accomplished by Applicant's proxy server. The termination of the data connection is performed by the mobile communication device after establishing an active status. Thus, the Examiner has failed to show that the '261 patent teaches or suggests the claimed elements of the mobile communication device

terminating said data connection while remaining in an active state status, and while a proxy server logs in/off the instant messaging service.

The above discussion supports Applicant's assertion that claim 1 is patentable over the '261 patent since the '261 patent does not teach every element of claim 1 as required under 35 U.S.C. 102(e). Also, since dependent claims 2, 4, 6-9, 12 and 14 are dependent upon a patentable base claim 1, Applicant respectfully requests that the Examiner issue a notice of allowance for claims 1, 2, 4 6-9, 12 and 14.

b. Independent claim 16, and dependent claims 17-24

Independent system claim 16 is not anticipated in view of the '261 patent since the '261 patent fails to teach or suggest each and every element of independent claim 16. Specifically, claim 16 comprises, inter alia,

"a proxy server having a first connection to the wireless communication network for sending and receiving the short messages, and a second connection to the data network for sending and receiving instant messages, wherein the proxy server is logged into the instant messaging service to provide an instant messaging proxy presence for the wireless communications device when the wireless communications device is in the active state status and when the data connection is either active or terminated."

Specifically, as discussed above, the '261 patent does not teach or suggest a proxy server which receives an active status from a wireless communication network, and then logs into the instant messaging service upon receipt of the active status to maintain an proxy presence. The servers described in the '261 patent provide routing services for users, whether or not the users are aware of the status of other users.

(See column 3, lines 46-63 as cited by the Examiner with reference to original claim 1.)

The claimed invention provides true active status of the mobile communications device even though the mobile communications device does not maintain a dedicated data connection with the wireless communication network, as a dedicated data connection is expensive, inefficient, and battery draining. Rather, the present invention utilizes a

proxy server to maintain a dedicated on-line data connection on the data network that reflects the actual active status of the mobile communication device.

Because the '261 patent does not teach or suggest the use of a proxy server as claimed by Applicant, the '261 patent does not anticipate independent claim 16 under 35 U.S.C. 102(e). Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for claims 16, and dependent claims 17-24.

c. Independent claim 25, and dependent claim 26

Independent method claim 25 is not anticipated in view of the '261 patent since the '261 patent fails to teach or suggest each and every element of independent claim 25. Specifically, claim 25 comprises, inter alia,

(a) "communicating an active state status from the wireless communications device to the wireless communication network utilizing at least one connection of the plurality of wireless data connections;"

(b) "terminating the at least one connection upon the establishment of the active state status;"

(c) "providing an instant messaging proxy presence from the proxy server to the instant messaging service upon receipt of the active state status, wherein the proxy server is a stand-in wireless communications device which maintains an online status for sending and receiving instant messages on the data network."

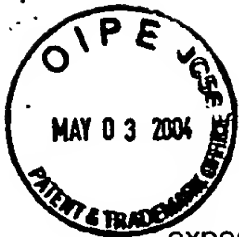
The '261 patent does not teach the method as claimed in the above listed element of claim 25. Specifically, the '261 patent does not teach or suggest that a wireless communications device communicates an active status on a data connection to a wireless communication network, and then terminates the data connection upon establishment of the active state status, wherein a proxy server maintains an online status upon receipt of the active status of the mobile communications device.

Because the Examiner has not shown the specific element of the invention as claimed in method claim 25 (in reference to the original claim 1), as required by 35

U.S.C. 102 (e), Applicant respectfully requests that the Examiner issue a notice of allowance for independent claim 25 and dependent claim 26.

E. Conclusion

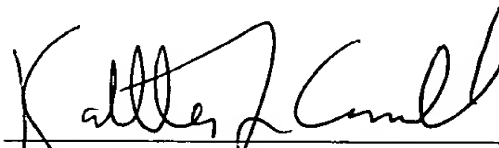
Applicant asserts that the pending claims are not anticipated under 35 U.S.C. 102(e) in view of the '261 patent as the '261 patent does not teach or suggest each and every element of the pending claims. Thus, Applicant respectfully requests that the Examiner issue a notice of allowance for all of the pending claims 1, 2, 4, 6-9, 12, 14 and 16-26.



Should the Examiner believe that prosecution of this application might be expedited by further discussion of the issues, he is invited to telephone the attorney for Applicant at the telephone number listed below.

Respectfully submitted,

Dated: April 30, 2004

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